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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,512	03/14/2001	Kayode A. Williams	UOM 0193 PUS	4539

22045 7590 03/10/2004
BROOKS KUSHMAN P.C.
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD, MI 48075

EXAMINER

PATEL, MITAL B

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 03/10/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,512

Applicant(s)

WILLIAMS ET AL.

Examiner

Mital B. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7,9-18 and 20-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-18 and 20-31 is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/18/04 has been entered.

Response to Amendment/Arguments

2. Applicant's arguments filed 2/18/04 have been fully considered but they are not persuasive.
3. Applicant's arguments with respect to claims 1-3, 5-7, and 9-12 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-7, and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickie et al (US 4896666) in view of Fukunaga et al (US 6003511).

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6. **As to claim 1**, Hickle teaches a medical pacifier **Fig. 3** for delivering gas to a patient, the pacifier comprising a nipple member **12** adapted to be received within an oral cavity of the patient, the nipple member having a conduit extending therethrough and an outlet opening **36** provided therein; and a base **14** attached to the nipple member and adapted to remain outside the oral cavity, the base including a generally continuous annular inlet opening **40** provided therein and a lumen **34** extending therethrough which is in fluid communication with the conduit of the nipple member, wherein the inlet opening for connecting with a standard breathing tube external to the patient, the breathing tube remaining external to the body such that gas can flow through the base and the nipple member for delivery via the outlet opening into the oral cavity of the patient. Hickle fails to explicitly teach the outer diameter of the inlet opening. However, Fukunaga does teach that a 15 mm diameter tube is desirable for pediatric use. Therefore, it would have been obvious for one of ordinary skill in the art to make the outer diameter of the inlet opening of Hickle to be 15 mm in diameter so that a tube for a pediatric patient may be connected to the inlet opening since the Hickle device is for pediatric use.

7. **As to claim 2**, Hickle teaches a medical pacifier wherein the base includes a base plate disposed generally perpendicular to a longitudinal axis of the nipple member, the base plate having a concave front surface facing the nipple member and a convex rear surface facing away from the nipple member.

8. **As to claim 3**, Hickle teaches a medical pacifier wherein the base further includes a connector **42** projecting from the rear surface of the base plate, wherein the

lumen extends through the connector and the inlet opening is disposed in a proximal end of the connector.

9. **As to claim 5**, Hickie teaches essentially all of the limitations except for the specific shape of the connector. However, Applicant has not set forth how the particular limitation solves a stated problem or is advantages over the prior art, or provides an unexpected result. Therefore, the connector of Hinkle would perform equally as well.

10. **As to claim 6**, Hickie teaches a medical pacifier wherein the outlet opening is provided in a distal end of the nipple member.

11. **As to claim 7**, pacifiers with a handle ring pivotally attached to the rear surface of the base plate are known in the art (see cited references).

12. **As to claim 9**, pacifiers wherein the nipple member is impregnated with medication (**See col. 5, lines 26-35**).

13. **As to claim 10**, Hickie teaches a medical pacifier wherein the pacifier is molded from a plastic material (**See Col. 5, lines 19-24**).

14. **As to claim 11**, Hickie teaches essentially all of the limitations except for wherein the pacifier is of one-piece construction. However, such a construction is known in the art (see cited references).

15. **As to claim 12**, Hickie teaches a medical pacifier **See Fig. 3** for delivering gas to a patient, the pacifier comprising a base **14** adapted to remain outside an oral cavity of the patient, the base having a generally concave front surface and a generally convex rear surface, a connector **42** projecting from the base rear surface which includes a generally continuous annular inlet opening **40** provided in a proximal end thereof and a

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lumen **34** extending therethrough; a nipple member **12** projecting from the base front surface adapted to be received within an oral cavity of the patient, the nipple member having a conduit extending therethrough which is in fluid communication and an outlet opening provided in a distal end thereof such that anesthetic gas can flow through the pacifier for delivery via the outlet opening into the oral cavity of the patient. Hickie fails to explicitly teach the outer diameter of the connector proximal end. However, Fukunaga does teach that a 15 mm diameter tube is desirable for pediatric use. Therefore, it would have been obvious for one of ordinary skill in the art to make the outer diameter of the connector proximal end of Hickie to be 15 mm in diameter so that a tube for a pediatric patient may be connected to the inlet opening since the Hickie device is for pediatric use.

Allowable Subject Matter

16. Claims 13-18 and 20-31 are allowed over the prior art of record.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2004/0040556 A1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mital B. Patel whose telephone number is 703-306-5444. The examiner can normally be reached on Monday-Friday (8:00 - 4:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 703-308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mbp


Aaron J. Lewis
Primary Examiner